

REMARKS

Claims 9, 11-18 and 21-25 are pending. By the Office Action, claims 9 and 11-25 are rejected under 35 U.S.C. §103. By this Amendment, claim 9 is amended and claims 19-20 are canceled. Support for amended claim 9 can be found in original claim 20. No new matter is added.

I. Rejections Under 35 U.S.C. §103

A. Chow and Reitz

Claims 9, 11-19 and 21-25 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,183,929 to Chow et al. in view of U.S. Patent Publication No. 2003/0057601 to Reitz.

Although Applicants do not necessarily agree with this rejections, in the interest of advancing prosecution claim 9 is amended to incorporate the subject matter of non-rejected claim 20. Claim 9 was previous amended to incorporate the alternative subject matter of claims 19 and 20; however, claim 9 is amended herein to delete the subject matter of claim 19, and claims 19 and 20 are accordingly canceled. Accordingly, claim 9 and its dependent claims are patentable over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Chow and Puyenbroek

Claims 9, 11-19 and 21-25 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,183,929 to Chow et al. in view of U.S. Patent No. 6,072,010 to Puyenbroek.

Although Applicants do not necessarily agree with this rejections, in the interest of advancing prosecution claim 9 is amended to incorporate the subject matter of non-rejected claim 20. Claim 9 was previous amended to incorporate the alternative subject matter of claims 19 and 20; however, claim 9 is amended herein to delete the subject matter of claim 19, and claims 19 and 20 are accordingly canceled. Accordingly, claim 9 and its dependent

claims are patentable over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Chow, Puyenbroek, and Carlini

Claim 20 is rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,183,929 to Chow et al. in view of U.S. Patent No. 6,072,010 to Puyenbroek, and further in view of U.S. Patent No. 6,439,711 to Carlini. As described above, claim 9 is amended to incorporate the limitations of claim 20. Applicants respectfully traverse this rejection with respect to amended claims 9, 11-18 and 21-25.

Chow and Puyenbroek are cited as disclosing all of the limitations of claims 9, 11-19 and 21-25. For all of the reasons previously presented by Applicants, Applicants disagree with the Office Action's citation of Puyenbroek as disclosing the claimed polyetherimide-b-polysiloxane block copolymer comprising etherimide blocks and siloxane blocks, wherein said copolymer contains more than 50% by weight of said siloxane blocks, and the polymer's use in a surface layer of a member for use in a copying device.

Carlini is cited for its disclosure of a typical ballistic aerosol marking printing system, which uses a transfuse member. The Office Action argues that it would have been obvious to utilize the fuser (transfuse) member of Chow and Puyenbroek in the system of Carlini. Applicants disagree.

Carlini admittedly discloses a transfuse member, at col. 12, lines 39-44. However, Carlini merely discloses therein that a generic transfuse member can be used. Carlini nowhere discloses, or even suggests, that any transfuse member can be used in the ballistic aerosol marking system, and does not teach or suggest specifically using the transfuse member provided by the asserted combination of Chow and Puyenbroek.

As is well known in the art, not all fuser or transfuse members are interchangeable within the context of a particular printing system. That is, the transfuse members themselves

are generally tailored for particular printing systems and/or printing environments, and thus would not provide adequate results in all printing systems. For example, as is known in the art, different transfuse members are used to accommodate for different toner and developer compositions, different printing architectures, different printing environments (such as temperature, pressure, humidity, and the like), and so forth. None of Chow, Puyenbroek, nor Carlini teach or suggest that all transfuse members are suitable for all printing systems, or particularly that the transfuse member allegedly provided by a combination of Chow and Puyenbroek would be suitable for use in the ballistic aerosol marking system of Carlini.

In fact, the only motivation for the asserted combination of references comes from Applicants' own disclosure and claims, which is improper. It is well settled that the reason, suggestion or motivation for combining the references "can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). That is, the motivation for combining the references can not be a product of hindsight reconstruction of the claimed invention based on Applicants' own disclosure. Such a hindsight reconstruction has clearly been made in the present Office Action. The Office Action asserts that the claimed invention would have been obvious over a combination of three unrelated references, based only on the hindsight selection of the claim limitations from the three references. Instead, none of the references suggest to one skilled in the art that the teachings could be combined and then further modified to render the claimed invention. Such a combination is improper because the references, viewed by themselves and not in retrospect, must suggest the combination asserted by the Office Action. *In re Shaffer*, 229 F.2d 476, 108 USPQ 326 (C.C.P.A. 1956); *In re Stoll*, 523 F.2d 1392, 187 USPQ 481 (C.C.P.A. 1975). Here the references do not provide any motivation for combining the unrelated teachings. The only motivation for combining the cited references in the manner asserted in the Office Action derives from the disclosure of the present application, which is clearly improper.

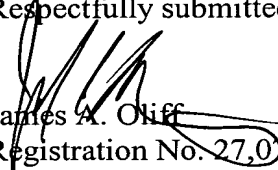
For at least these reasons, the Office Action has failed to establish a prima facie case of obviousness of the claimed invention. Accordingly, claim 9 and its dependent claims are patentable over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

II. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the above-identified patent application is in condition for allowance. Favorable consideration and prompt allowance are therefore respectfully requested.

Should the Examiner believe anything further would be necessary in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,


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